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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/978,636 11/25/97 RABBBANI

E ENZ-53(DIV-3)

EXAMINER

SCHMIDT, M

ART UNIT

PAPER NUMBER

1635
DATE MAILED:

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11/10/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/978,636

Applicant(s)

Rakanni et al

Examiner

Sumner

Group Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 8/23/99

☒ This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 245 260 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- ☒ Claim(s) 245 260 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413

Notice of References Cited, PTO-892 _____ Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948 _____ Other _____

Office Action Summary

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DETAILED ACTION

Double Patenting

1. Claims 255, 257 and 259 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 245-247 of copending Application No. 08/978,635, for the same reasons of record set forth in the Official action mailed 02/18/99.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Acknowledgment is made of the intention to wait for allowable subject matter in one or both applications before further responding to the double patenting rejection in the reponse filed 08/23/99.

Claim Rejections - 35 USC § 112

2. Claims 245-260 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for the same reasons of record set forth in the Official action mailed 02/18/99.

Applicant's arguments filed 8/23/99 have been fully considered but they are not persuasive.

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Applicant's response provides only an assertion that an ordinarily skilled artisan, armed with the specification, could practice the invention without undue experimentation. This assertion, without any supporting evidence, fails to overcome the *prima facie* case of lack of enablement.

3. Claims 245-260 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the same reasons of record set forth in the Official action mailed 02/18/99.

Applicant's arguments filed 8/23/99 have been fully considered but they are not persuasive. Applicant's response provides only an assertion that the instant claims are of proper breadth and scope to convey to one skilled in the art that the inventors had possession of the claimed invention. This assertion, without any supporting evidence, fails to overcome the lack of written description in the specification as filed for the broad genus of possible constructs claimed.

Claim Rejections - 35 USC § 102

4. Claims 245-249 and 253 rejected under 35 U.S.C. 102(e) as being anticipated by Saito et al., for the same reasons of record set forth in the Official action mailed 02/18/99.

Applicant's arguments filed 8/23/99 have been fully considered but they are not persuasive.

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Applicant does not address how Saito does not teach nor suggest the claimed invention and thus fails to overcome the rejection.

5. Claims 245-247 and 249-254 rejected under 35 U.S.C. 102(e) as being anticipated by Wagner et al., for the same reasons of record set forth in the Official action mailed 02/18/99.

Applicant's arguments filed 8/23/99 have been fully considered but they are not persuasive. Applicant does not suggest how the material elements taught by Wagner et al. do not share material identity with the scope of possible constructs instantly claimed.

6. Claims 255-260 are rejected under 35 U.S.C. 102(e) as being anticipated by Sullenger et al., for the same reasons of record set forth in the Official action mailed 02/18/99.

Applicant's arguments filed 8/23/99 have been fully considered but they are not persuasive. Applicant does not suggest how the material elements taught by Sullenger et al. do not share material identity with the scope of possible constructs instantly claimed.

7. Claims 255-260 are rejected under 35 U.S.C. 102(b) as being anticipated by DeYoung et al., for the same reasons of record set forth in the Official action mailed 02/18/99.

Applicant's arguments filed 8/23/99 have been fully considered but they are not persuasive. Applicant's response provides only an assertion that DeYoung et al. fails to anticipate the

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disclosed invention. This assertion, without any supporting evidence, fails to overcome the rejection.

Claim Rejections - 35 USC § 103

8. Claims 245-260 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Young et al. In view of Karn et al., Wagner et al., Curiel et al, and Zaia et al., for the same reasons of record set forth in the Official action mailed 02/18/99.

Applicant's arguments filed 8/23/99 have been fully considered but they are not persuasive in view of the failure to overcome the rejections over De Young et al. and Wagner et al. above and since the assertion by applicant that the combination of references would not have made the claimed invention obvious to one of ordinary skill in the art. This assertion, without any supporting evidence, fails to overcome the *prima facie* case of obviousness.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

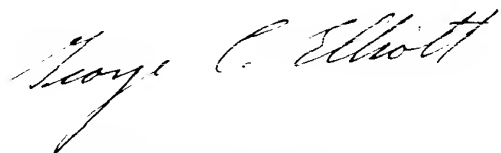
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Mary M. Schmidt*, whose telephone number is (703) 308-4471.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *George Elliott, Ph.D.* may be reached at (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



George C. Elliott, Ph.D.
Supervisory Patent Examiner
Technology Center 1600

M. M. Schmidt
November 8, 1999